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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,713	04/19/2000	Koukichi Masumoto	3064NG/48834	3146

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EXAMINER

TUGBANG, ANTHONY D

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 02/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/552,713

Applicant(s)

MASUMOTO, KOUKICHI

Examiner

Dexter Tugbang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 2,4 and 6-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restriction***

1. The applicants' amendment filed 7/10/02 (Paper No. 7) has been fully considered and made of record. The amendment has necessitated the following restriction requirement.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 3, 5, 9 and 10 drawn to a fixing holder, classified in class 29, subclass 741.
  - II. Claims 2, 4, 6, 8, 11 and 12, drawn to an assembly, classified in class 174, subclass 250.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions of Groups II and I are related as combination and subcombination, respectively. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (Group II) as claimed does not require the particulars of the subcombination (Group I) as claimed because Group II does not require the specifics of a side surface of the holder main body portion on a side where the forward side opening is formed includes a projection protruding forward and adapted to engage with the printed circuit board, as required by Group I. The subcombination has separate utility such as a projection to engage a printed circuit board.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. If applicants' elect the invention of Group I, this application contains claims directed to the following patentably distinct species of the claimed invention:

Species A, Claim 3, drawn to a slanted surface formed at a lower end portion of the flat surface; and

Species B, Claims 9 and 10, drawn to the projection protruding substantially orthogonally with respect to the longitudinal direction of the holder.

NOTE: Species A is mutually exclusive from Species B and Species B is mutually exclusive from Species A.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 1 and 5 are generic to the invention of Group I.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Newly submitted Claims 8-12 and amended Claims 2, 4 and 6 are directed to an invention that is independent or distinct from the invention originally claimed for the reasons set forth above.

Since applicant has received an action on the merits for the originally presented invention (Group I, Species A), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claims 2, 4, 6 and 8-12 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

7. Claim 7 continues to stand as being withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4.

### ***Drawings***

8. The drawings are objected to because the portion of Figure 1A showing the feature of the rail G should be a separate figure and also should be labeled as --Prior Art--. Furthermore,

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Figures 3A-3C should be labeled as --Prior Art--. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 5, the inconsistency between the language in the preamble “The fixing holder...” (line 1) and certain portions of the body of the claim such as “...the wire-shaped leg portions...” (lines 5-6) renders the scope of the claims as being vague and indefinite because it is unclear if the intent is to claim either the subcombination of the fixing holder alone or the combination of the fixing holder and structure of the electronic component. The applicant is asked to please clarify what subject matter the claim is intended to be drawn to where the language of the preamble of the claims are to be amended to be consistent with this intent.

NOTE: For examination purposes, the examiner assumes the applicant intended to claim the subcombination of the “fixing holder” alone.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claim 1, 3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Ingaglio 4,399,608.

Regarding Claim 1, Ingaglio discloses a fixing holder having a cylindrical shaped holder (shown in Fig. 1) comprising: a holder main body portion (rod 21); a base portion (slot 25); a side opening (bottom end of slot 25) with a flat surface 24 and projection (anyone of tabs 26 or 27) protruding forward, which is capable of engaging with a printed circuit board.

With respect to fixing holder having the structural limitations of the holder being hollow in a longitudinal direction and having top and bottom openings (lines 4-5 of Claim 1), these limitations recited in the preamble of the claims are intended use limitations and have not been given patentable weight since the body of the claims do not depend upon the preamble for completeness and the structural limitations of the fixing holder are able to stand alone. *In re Hirao*, 535 F.2d 67 190 USPQ 15 (CCPA 1976).

Regarding Claim 3, the claimed “slanted surface” is read as the bottom surface of tab 23, which can said to be slanted (in Fig. 2) 90 degrees or perpendicular to the flat surface 24 and is at a lower portion of the flat surface.

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Regarding Claim 5, the limitations of “the wire-shaped leg portions...the opening” (lines 5-6) have not been any patentable weight as these limitations do not patentably further limit the claimed “fixing holder”. The holder main body portion 21 is capable of being inclined forward.

***Response to Arguments***

13. Applicant's arguments filed 7/10/02 have been fully considered but they are not persuasive.

In regards to the merits of Ingaglio, the applicant contends that Ingaglio is not a fixing holder, but is a tool, and that the holder is not hollow including top and bottom openings.

The examiner traverses because the structure of the tool of Ingaglio reads on the structure of the applicants' claimed invention of the fixing holder. It is noted that claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

With respect to the holder being hollow and having top and bottom openings, the examiner acknowledges that Ingaglio is deficient regarding this feature. However, the body of Claim 1 (lines 8-17) and the limitations of dependent Claims 3 and 5, do not provide any structural interconnection with the holder being hollow having top and bottom openings. The body of the claims can stand alone and do not rely upon the preamble for completeness. As such, the above features of the holder being hollow with top and bottom openings have not been given any patentable weight.



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Regarding Claim 3, the claimed "slanted surface" is considered to be met and inclusive of rejection set forth above, particularly that the bottom surface of tab 23 is being read as the "slanted surface".

*Conclusion*

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dexter Tugbang whose telephone number is 703-308-7599. The examiner can normally be reached on Monday - Friday 9:00 am - 5:30 pm.

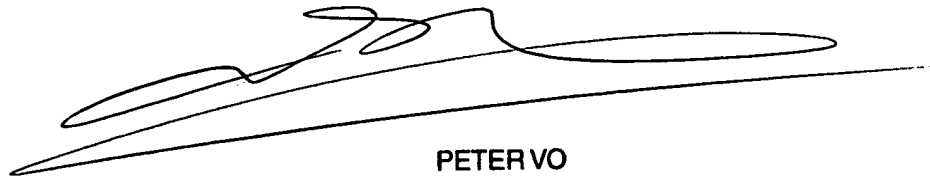
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3588 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

adt  
February 20, 2003

A handwritten signature in dark ink, appearing to read 'PETER VO', is written over a horizontal line.

PETER VO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700